

REMARKS / ARGUMENTS

The present application includes pending claims 1-32, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth “all reasons and bases” for rejecting the claims.

Claims 1-9, 11-19, 21-29, 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 5,371,738 (“Moelard”), in view of USP 5,875,185 (“Wang”). Claims 10, 20 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moelard in view of Wang and further in view of USP 7,200,673

("Augart"). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a

prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Moelard and Wang Does Not Render Claims 1-9, 11-19, 21-29, 31 and 32 Unpatentable

A. Independent Claims 1, 11 and 21

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Moelard and Wang does not disclose or suggest at least the limitation of “identifying a location of a network device within the hybrid wired/wireless network, the network device being movable within the hybrid wired/wireless network,” as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

Regarding claim 1, Moelard discloses a method for providing location based configuration in a hybrid wired/wireless network, the method comprising:

- identifying a location of a network device (identifying the location of the mobile wireless station (MWS), see 30 fig.7 and col.2, ln.56-59) within the hybrid wired/wireless network (fig.7), the network device being movable within the hybrid wired/wireless network (mobile wireless station, see 30 fig.7);
- determining configuration information (switch MWS to BS2 for handover, see 216 fig.11) corresponding to the determined location of the network device (identifying the location of the mobile wireless station, see 30 fig.7 and col.2, ln.56-59); and
- communicating the determined configuration information to the network device (request and response regarding to the location of MWS, see

218-212 fig.11) for providing location based configuration of the network device (switching the MWS to BS2, see 224 fig .11).

Moelard discloses that MSW decides to handover communication from a BS1 to BS2 as described in col.2, ln.58-60, but silent on the added limitation "determining, outside of the network device, configuration information for the network device." However, Wang discloses the handoff method based on the intra-switch mobility or inter-switch mobility and the switch, outside of the mobile network device, determines if mobile mobility is intra or inter switch (see fig.4, fig.6, 108 fig.9A, and col.8, ln.42-45). That is, the switch, outside of the network device, determines configuration information of hand-over for the mobile network device, the configuration information corresponding to the determined location of the network device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to apply the handoff method based on the intra-switch mobility or inter-switch taught by Wang into the handover method of Moelard in order to decide if MWS's mobility is intra or inter switch within a different network configuration having the switch is connected to a plurality of base stations (Wang, col.8, ln.42-45).

See Final Office Action at pages 2-3. The Final Office Action relies on col. 2, lines 56-59 of Moelard, which simply discloses that each base station may maintain a dynamic filtering database with locations of the mobile terminal **in relation to the base station**. **In other words, Moelard determines whether the mobile terminal is somewhere within the coverage area of the base station.** However, Moelard does not determine the specific geographic location of the mobile terminal, and Moelard does not disclose that finding the coverage area of the base station is equivalent to identifying a location of the mobile device, or that the location of the base station is used in any way to identify the location of the mobile device. There is simply no determining of the geographic location of the mobile device within the network. Wang does not overcome the above deficiencies of Moelard.

Furthermore with regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Moelard and Wang does not disclose or suggest at least the limitation of “determining, outside of said network device, configuration information for said network device, said configuration information corresponding to said determined location of said network device,” as recited by the Applicant in independent claim 1. The Final Office Action relies for support on Fig. 11 (step 216) of Moelard, which illustrates a flowchart of the operation of the mobile wireless station during a hand-over procedure. Initially, the Applicant points out that **making the handover decision (step 216 in Fig. 11; switching the MWS to BS2) has nothing to do with determining configuration information for the MWS. The Examiner has not provided any argument or citation establishing that making a handover decision is, somehow, equivalent to determining configuration information. Obviously, a mobile terminal has to be configured and operating, in order for it to make a handover decision. Moelard, therefore, is distinguished based on this ground alone.**

Even if we assume, arguendo, that making the handover decision is somehow equivalent to determining configuration information (which it is not), the Examiner’s argument is still deficient. More specifically, Moelard discloses that the handover decision is, in fact, made **by the MWS itself, not outside of the MWS** (See Moelard at col. 6, lines 32-34). In this regard, it is not possible, under Moelard, for such handover decision (equated by the Examiner to Applicant’s

“determining ...configuration information”) to be made outside of the MWS, as recited in Applicant’s claim 1. The Examiner has conceded, in the above citation, that Moelard does not disclose "determining, outside of the network device, configuration information for the network device." The Examiner then relies for support on fig.4, fig.6, fig.9A, and col.8, ln.42-45 of Wang.

Initially, the Applicant points out that Wang discloses two types of handoff – intra-switch (the old and new base stations are both connected to the same switch) and inter-switch (the old and new base stations are each connected to separate switches). Intra- and inter-switch types of handoff are discussed in greater detail in col. 5, line 41 – col. 8, line 15 of Wang. Even though both types of handoff differ in how the handoff path between the mobile terminal (MT) and the new base station is set up, both intra- and inter-switch types of handoff have similar features. For example, **in both intra- and inter-switch types of handoff, the MT initiates the handoff by issuing two messages – a “location message” (containing the location of the new base station) and a “connection message” (containing the virtual channel set-up parameters and virtual channel handoff connections).** In this regard, Wang’s MT issues the “connection message” for purposes of setting up the virtual channel and initiating the handoff sequence using the virtual channel. See Wang at col. 8, lines 30-45. Even though Wang’s switch (connected to the original base station) determines whether inter- or intra-switch type of handoff applies (as stated in the citation used by the Examiner - col. 8, lines 42-45), the fact remains that the handoff has already been

initiated by the MT communicating the "location" and "connection" messages. This is further supported by Wang's claims 1 and 3, which are disclosed in col. 10, lines 18-67. Therefore, Wang does not overcome the deficiencies of Moelard and does not disclose "determining, outside of the network device, configuration information for the network device."

Therefore, the Applicant maintains that the combination of Moelard and Wang does not disclose or suggest at least the limitation of "determining, outside of said network device, configuration information for said network device, said configuration information corresponding to said determined location of said network device," as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Moelard and Wang does not disclose or suggest at least the limitation of "communicating said determined configuration information to said network device for providing location based configuration of said network device," as recited by the Applicant in independent claim 1. The Examiner, again, relies on the flowchart of Fig. 11. As already explained above, all the decisions regarding the handover process are made within the MWS, not outside of the MWS. The Examiner has already equated the "determined configuration information" to the determination made in step 216. However, **such determination is made within the MWS and it cannot be communicated to the MWS**, as alleged by the Examiner.

Accordingly, the proposed combination of Moelard and Wang does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-9, 12-19 and 22-29

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Moelard in view of Wang has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-9, 12-19 and 22-29 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-9, 12-19 and 22-29.

II. The Proposed Combination of Moelard, Wang and Augart Does Not Render Claims 10, 20 and 30 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being anticipated by Moelard has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Augart) does not overcome the deficiencies of Moelard, claims 10, 20 and 30 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 10, 20 and 30.

In general, the Final Office Action makes various statements regarding claims 1-32 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-32 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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